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Response to Office Communication

REMARKS

Applicants have now had an opportunity to carefully consider the comments set forth in the Office Action of January 31, 2008. Claims 1, 8, 10, 13-15, 21, 28-30, 32-33 and 37 have been amended. Claims 11, 16, 31, 36 and 39 have been cancelled. New claims 42-43 have been added. Applicants respectfully submit that new claims 42-43 find support in the original application as originally filed. No new matter is believed to have been introduced.

Claim rejection based upon 35 USC 102(a)

Claim 21 is rejected under 35 USC 102(a) as being anticipated by Dotsubo US Patent 6,556,243 (hereinafter "Dotsubo"). In response, Applicants submit the following.

Claim 21 has been amended to recite capturing a first image from only a portion of an original image based upon a selection of the user, processing the first image and printing the processed image in a background layer of a second image. Capturing only a user-selected portion of the original image as the first image advantageously allows for the ability to greater customize a background layer (the processed image) for an image (the second image).

In contrast, Dotsubo makes no mention of capturing only a portion of an image for use in a background layer of a second image, much less the image portion being user-selected. Though mention may possibly be made in Dotsubo of reconciling the resolution of title/template images with the resolution of the photograph, such resolution reconciliation does not suggest or imply capturing only a user-selected portion of an original document for use in a background of a second image.

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Claim 21 further recites that the processing processes a combination of the first image's

size, shape and intensity based upon user selection, to produce the processed image. The

invention of claim 21 advantageously allows for great customization in creating a background

layer for an image. Dotsubo is stated in the outstanding Office Action as processing size by the

above resolution reconciliation and processing shape and intensity due to applying a low pass

filter on the title images. On the contrary, Applicants respectfully submit that modifying

(reducing) the resolution of an image does not amount to affecting (reducing) the size of an

image. In Dotsubo, the title/template image remains the same size (see Figs. 5 and 6). In

addition, the low pass filtering that is performed on the title image in Dotsubo merely prevents

ringing from occurring when boundaries between photographed image and the title image are

combined (col. 8, lines 55-65) – neither the shape nor the intensity of the title image are stated in

Dotsubo to be affected or otherwise processed.

Based upon the foregoing, Applicants respectfully submit that claim 21 and the claims

which depend therefrom are unanticipated by and allowable over Dotsubo.

Claim rejection based upon 35 USC 103(a)

Claims 1 stands rejected under 35 USC 103(a) as being unpatentable over Dotsubo in

view of Schinner US patent publication 2004/0218206 (hereinafter "Schinner"). In response,

Applicants submit the following.

Claim 1 recites an image capturer configured to capture a first image from only a potion

of the original image, where the size, shape, or intensity of the first image, or a combination of

the first image's size, shape, and intensity is based upon the selected capture-to function, and a

print engine configured to print the first image as a background layer in a copy. Dotsubo is

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stated in the outstanding Office Action as showing the size, shape and/or intensity of the first image is based upon the user-selected function. Applicants believe this is incorrect. As stated above, any changes in resolution cannot be seen as a change in the first image's size, and the low pass filter in Dotsubo only prevents ringing – no mention is made that the shape or intensity of the first image is affected by the low pass filter.

In addition, Dotsubo fails to show or even remotely suggest capturing a first image from only a portion of the original image based upon a user-selected capture-to function as recited in amended claim 1. Applicants respectfully submit that Dotsubo is silent as to capturing only a portion of the first image.

Applicants respectfully submit that Schinner fails to overcome the deficiencies of Dotsubo. In an absence of any teaching or suggestion of an image capture and printing device having an image capturer as recited in amended claim 1, Applicants respectfully submit that amended claim 1 and the claims which depend from claim 1 are allowable over Dotsubo and Schinner.

Claims 7-8 and 11 stand rejected under 35 USC 103(a) as being unpatentable over Dotsubo in view of Schinner and further in view of Wnek US patent 5,633,678. In response thereto, Applicants respectfully submit that claims 7-8 and 11 are believed to be allowable for the reasons presented above with respect to independent claim 1. In addition, Applicants respectfully submit that claim 8 as amended recites capturing top and bottom portions of the original image without analyzing content of the original image. Wnek does not appear to show or suggest capturing top/bottom portions of an original image, much less such capturing without

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analyzing the contents of the original image as claimed. In an absence of any showing or

suggestion of a device having a capture-to header/footer function as recited in claim 8, claim 8

and the claims which depend therefrom are believed to be allowable.

Claims 12-16 stand rejected under 35 USC 103(a) as being unpatentable over Dotsubo in

view of Schinner and further in view of Nihei US patent 7,098,924. In response thereto,

Applicants respectfully submit that Nihei fails to overcome the deficiencies of Dotsubo and

Schinner. Further, claim 13 has been amended to recite that the capture-to border/frame function

captures a subset of top, bottom, left and right portions of the original image without analyzing

content of the original image. In contrast, Nihei shows a system in which a user simply selects a

type of border to be used for each image. Applicants respectfully submit that the Nihei

altogether fails to show capturing a subset of top, bottom, left and right portions of an original

image and printing the first image as a background layer, as recited in claim 13. In an absence

of any teaching of a device having a border/frame capture-to function as claimed, claim 13 and

the claims which depend from claim 13 are believed to be allowable over the references of

record.

With respect to claim 15, Applicants respectfully submit that Nihei fails to show or

suggest a size portion of the original image captured is user selected. As a result, claim 15 is

believed to be allowable as a result.

Claims 27-28 stand rejected under 35 USC 103(a) as being unpatentable over Dotsubo in

view of Wnek. In response thereto, Applicants respectfully point out that claim 28 as amended

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recites that capturing the first image comprises scanning the top and bottom portion of the
original image without regard to the content thereof. The claim invention advantageously allows
one to capture portions of any type of document for use as a background layer of another image.
In contrast, Wnek appears to disclose a system which performs machine learning based in part
upon the content of a document. Unlike the complicated system of Wnek, there is no "learning"
needed by the invention of claim 28 - the user simply selects a capture-to function and the
claimed invention captures top and bottom portions of the original image, all without any content
analysis of the original document. In the absence of a method as recited in amended claim 28,
Applicants respectfully submit that claim 28 and the claims which depend from claim 28 are
allowable over Dotsubo and Wnek.

Claims 29-30 stand rejected under 35 USC 103(a) as being unpatentable over Dotsubo in
view of Wnek and further in view of Nihei. In response, Applicants point out that claim 30,
which depends from claim 28, additionally recites that the size of the top and bottom portions of
the original image scanned is user determined. The invention of claim 30 advantageously allows
for greater ability to customize a border region by capturing a user-selected amount of an
original image. In the outstanding Office Action, Nihei is relied upon for showing border size
being user-selected. On the contrary, Nihei merely shows selecting a border pattern and sizing
and positioning a separate, foreground image relative to the selected border. Applicants
respectfully submit that enlarging and positioning a foreground image is not at all the same as
capturing top/bottom portions of an original image, and sizing such captured portion based upon

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user input, for use as a background layer of a second image. In an absence of a method as recited

in claim 30, claim 30 is believed to be allowable.

Claims 32-40 stand rejected under 35 USC 103(a) as being unpatentable over Dotsubo in

view of Nihei. In response thereto, Applicants submits the following.

Claim 32 as amended recites that the first image capturing comprises capturing only an

image of a border of the original image. The claimed invention advantageously allows for

greater flexibility in creating background layers for images. In contrast, Nihei merely shows a

user selecting from various predetermined borders for use in a composite image. Nowhere in

Nihei is there mention or suggestion of creating a border, much less capturing a border from an

original image as claimed. Dotsubo fails to remedy the shortcomings of Nihei. As a result,

claim 32 and the claims which depend therefrom are believed to be allowable.

Similarly, claim 37 recites that the first image capturing comprises scanning only an

upper portion of the original image. As stated above, Nihei and Dotsubo fail to disclose or

suggest scanning only the upper portion of the original image. In particular, Nihei merely shows

the selection by a user from among a plurality of predetermined borders. In absence of any

showing or suggestion of a method as recited in claim 37, claim 37 and the claims which depend

therefrom are believed to be allowable.

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New claims 42-43 recite a method for creating an image as a background layer for a second image, including capturing only a portion of a first image based upon a capture mode selected by a user, without regard to content of the first image. Applicants respectfully submit that no reference relied upon in rejecting claims 1-41, either alone or in combination, show or suggest the method of claim 42. New claims 42-43 are believed to be allowable as a result.

Conclusion

Applicant respectfully submits that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, applicant respectfully submits that all pending claims are in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone or email the undersigned at the numbers provided.

Respectfully submitted,

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